

3600

**RESPONSE UNDER 37 CFR 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 3641**

Fax Transmission

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From: Mitchell R. Swartz, MD, ScD
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s? Call (781) 237-3625
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(please call first)

MAY 12 2003

GROUP 3600

To: Patent Commissioner
Dr. Nicholas P. Godici

Group Art Unit: 3641
Examiner Palabrica

**PETITION TO THE
COMMISSIONER**

Address: BOX AF
The Commissioner of Patents and
Trademarks
Washington, D.C. 20231

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paper
18
AFTER FINAL

Date:

**RESPONSE UNDER 37 CFR 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 3641**

Time:

Pages:

Re: Serial no. 09/ 750,765
Filed: 12/28/00

**RESPONSE UNDER 37 CFR 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 3641**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor : Mitchell R. Swartz

Serial no. 09/ 750,765

Filed: 12/28/00

For: **METHOD AND APPARATUS
TO CONTROL ISOTOPIC FUEL
LOADED WITHIN A MATERIAL**

This is a continuation of Serial no. 07/ 760,970

Filed: 09/17/1991

Group Art Unit: 3641

Examiner: Mr. Palabrida, R.J.

May 6, 2003

Patent Commissioner Nicholas P. Godici

Dear sir:

In the above-entitled application, there has been neither fairness nor compliance with the usual standards of review. This is discussed in the attached Petition and supporting Declaration, and elsewhere.

Thank you for your time and attention to this important matter which to date has not been addressed.

Respectfully submitted,


Mitchell R. Swartz, ScD, MD
Weston, MA

**RESPONSE UNDER 37 CFR 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 3641**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor : Mitchell R. Swartz

Serial no. 09/ 750,765

R.J.

Filed: 12/28/00

For: **METHOD AND APPARATUS
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LOADED WITHIN A MATERIAL**

This is a continuation of Serial no. 07/ 760,970

Filed: 09/17/1991

Group Art Unit: 3641

Examiner: Mr. Palabrica,

Commissioner of Patents and Trademarks
Washington, D.C. 20231

May 5, 2003

**PETITION TO THE COMMISSIONER
PURSUANT TO 37 C.F.R. 1.181**

1. This Petition is made pursuant to 37 C.F.R. 1.181 to the Commissioner of Patents, and is made to invoke his supervisory authority to correct the situation with respect to the recent Office Communication [Exhibit "A" attached, mailed 3/20/03, and as described below]. Pursuant to 37 C.F.R. 1.181, there is no fee. This Petition is reasonable, based upon the reasons stated below and confirmed by the facts as discussed in the Declaration supporting this Petition.

2. In the discussion below, reference is made to the Declaration of Dr. Mitchell Swartz (hereinafter called the "Swartz Declaration") dated May 5, 2003. It will be demonstrated that this motion is reasonable because of Mr. Palabrica's failure to follow a uniform standard of review.

3. The Examiner cites scores of new references but there is no Form 1449. Applicant requests that one be provided now, and an explanation of its absence.

4. The Examiner did not include and return his checked-off Form 1449 of the Exhibits which Applicant supplied to rebut the Examiner. This is wrong at least two ways. First, it is improper because the Exhibits and Forms were provided two (2) times before, as certified by the official stamp of the Office [Exhibit "B", attached]. Second, this happened in another case, too, and Applicant requests that both be addressed and the Forms supplied, along with the latest Forms 1449 submitted herein to rebut the new additional inaccurate statements and new material of the Examiner, thrown at the Applicant at FINAL.

5. The Examiner has not addressed several sections of Applicant's Response of 12/3/02 and many of the Examiner's previous questions have simply been re-asked which is unfair and is a harassment because the previous response (before FINAL) had Declarations and Exhibits which have not been substantively addressed. This is discussed in detail in Applicant's Response to said 3/20/03 Communication from the Office.

6. The Examiner has not addressed the previously-submitted Declarations, merely giving false explanations without foundation. This is especially wrong, in the light of the Examiner citing the parent application [970] but failing thereafter to answer previous Orders of the Board to deal with said Declarations.

7. The invention at issue in this case, '765, claimed by Claims 1-10, 12-19, 21, and 22, is generally speaking a two-stage process involving loading of hydrogen into a metal electrode such as palladium, including a first stage of electrode loading, followed by, a second stage of sudden rapid ('catastrophic') flow of the loaded hydrogen within the metal and means to extract product using magnetic field inhomogeneity, based on differential magnetic susceptibilities.

Claim 12 not 2! M 5/20/03

8. The Examiner states,

"Change from "applied magnetic field" to "applied spatially inhomogeneous magnetic field", shown as underlined in amended claim 2."

THE TRUTH - Not New Material

The Examiner's claim that "homogeneous" magnetic fields, "spatially homogeneous", "redistribution of isotopic fuel into said material", are new is absolutely false. First, these could hardly be new material because they were discussed in the patent application of which the present application is a continuation ('970), and the present application which discussed this. The concepts and words were used in the original application. Second, proving this are the several Declarations which were submitted previously.

Third, there are orders (Exhibit "C") for the Examiner to address the declarations of Dr. Swartz and Strauss which discuss exactly this. How could it be new? And where is the response? Where is the evidence that the Examiner has ever addressed

any of the declarations substantially? Therefore, the Applicant requests the Examiner reconsider this issue.

9. The Examiner states:

"...this "something additional", this critical feature, must be clearly specified so as to enable the artisan to make and use the invention as required by statute."

THE TRUTH - Critical Features Were Specified And Claimed And Discussed Previously

The Examiner is disingenuous in the matter of a "critical feature" because the applicant has already diligently supplied information of several critical features which were taught in the original specification of the above-entitled application several times. These were fully discussed in the previous communication from the applicant to the Examiner, dated 12/3/02. The nature of the invention, along with introduction of some of the Declarations, was discussed in the previous communication from the Applicant to the Examiner, dated 12/3/02, on page 11 and 12. The operability of this invention was discussed in the previous communication from the Applicant to the Examiner, dated 12/3/02, including on pages 57 through 85. The role of loading in the operability of this invention was discussed in the previous communication from the Applicant to the Examiner, dated 12/3/02, on pages 57-58. The role of the optimal operating point in the operability of this invention was discussed in the previous communication from the Applicant to the Examiner, dated 12/3/02, on pages 59-60 and 66. The equations associated with the loading, and the catastrophic behavior of the loaded isotopic fuel, was discussed in the previous communication from the Applicant to the Examiner, dated 12/3/02, on pages 61 through 65, and 70-71. Applicant's extensive publications, and supporting publications, was discussed in the previous communication from the Applicant to the Examiner, dated 12/3/02, on pages 72-74. Where is the Examiner's substantive response to most or all of this? The Examiner has ignored many of the Applicant's detailed Arguments.

10. The Examiner states:

"There is neither an adequate description ... voltage and current requirements to produce the magnetic field"

THE TRUTH - "Voltage ... To Produce Magnetic Field" Heralds Examiner's Lack Of A Serious Physics Education

The Examiner asks for the "voltage .. requirements to produce the magnetic field". This is incredible. Certainly any engineer or physicist, would KNOW Ampere's Law. The line integral of the magnetic field intensity around a line electrical current is related to that current. Not voltage. The Examiner's statement finally reveals him to have no interest in the Applicant's invention, but only to savage and harass the Applicant with non-scientific chatter. The Applicant hereby requests from the Examiner --or the Commissioner for Patent-- to explain the above statement by the

Examiner. The Applicant --and truth, justice and the American way-- challenge the Office, Examiner and Commissioner, to name some inventions in the Office's history which violate Ampere's law. Applicant, who has four electrical engineering degrees from MIT (BS, MS, EE '71) and ScD '84 requests that the Examiner and Commissioner explain the latest demand and demonstrate a basis for physics and science competence by the Examiner and his supervisors.

Furthermore, this AGAIN PROVES that the Examiner has no interest in the Applicant's invention.

WHEREFORE for the above reasons, the Applicant respectfully requests a response to the above comments, and a substantive, precise and complete explanation of why the submitted unrebutted Declarations, Exhibits, data, and sterling references remain ignored without response. The latter, if necessary, will facilitate the Appeal, or complaint, by settling, resolving or simplifying the matter. The Applicant requests sanctions against the Examiner for harassment and for asking what "voltage" was used to generate a magnetic field, knowing full well that this was a absurd and a trick by the Examiner rather than following the motto of the Office.

Respectfully submitted,



Mitchell R. Swartz, ScD, MD, EE
Post Office Box 81135
Wellesley Hills, Mass. 02481

Certificate Of Mailing [37 CFR 1.8(a)]

May 5, 2003

To Whom it Does Concern:

I hereby certify that this correspondence will be deposited with the United States Postal Service by First Class Mail, postage prepaid, in an envelope addressed to
"Commissioner for Patents
P.O.Box 1450, Alexandria, VA 22313-1450"
on the date below. Thank you.

Sincerely,



May 5, 2003

M.R. Swartz

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,765	12/28/2000	Mitchell R. Swartz		8044

7590 03/20/2003
Mitchell R. Swartz, ScD, EE, MD
16 Pembroke Road
Weston, MA 02493

EXAMINER

PALABRICA, RICARDO J

ART UNIT

PAPER NUMBER

3641

DATE MAILED: 03/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

EXHIBIT "A"

The date stamp of the United States Patent Office
on this postcard will indicate receipt of:

1. Applicant's Amendment Response to Communication of 7/22/02
2. with a Certificate of Mailing on the last page.
3. Exhibit "REQ" Showing The Request
4. Exhibit "REC" With Date-Stamp Proving Receipt Of
Declaration, References, Forms PTO-144,
Other materials and Appendix "Introduction to Barriers", and
5. This self-addressed stamped postcard.

S.N. 09/750,765 Filed: 12/28/00

Thank you.

Mailed: December 3, 2002 Mitchell Swartz



The date stamp of the United States Patent Office
on this postcard will indicate receipt of:

1. Applicant's Response to Communication of 7/22/02.
2. with a Certificate of Mailing on the last page.
3. Version With Markings To Show Changes Made,
4. Declaration Of Dr. Mitchell R. Swartz,
5. A packet of Additional Declarations.
6. Several packets of References.
7. Accompanying Forms PTO-1440.
8. From '970: Amendment under Rule 116 (11/2/93)
9. From '970: Reply Brief to Examiner (4/23/94),
10. Appendix "Introduction to Barriers", and
110. This self-addressed stamped postcard.

S.N. 09/750,765 Filed: 12/28/00

Thank you.

Mailed: October 22, 2002 Mitchell Swartz

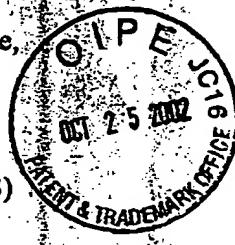


EXHIBIT "B"

EXHIBIT 'S' (4 PAGES)

Paper No. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

OCT 13 1995

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCESEx parte MITCHELL R. SWARTZ

Appeal No. 94-2920

Application 04/760,970

ORDER REMANDING TO EXAMINER

An Information Disclosure Statement was filed April 28, 1994 (Paper No. 34). A review of the file reveals that such Information Disclosure Statement was not considered by the Primary Examiner. It is not apparent from the record that the examiner notified applicant of whether this paper was considered and of whether their submission did not meet the criteria set forth in 37 C.F.R. §§ 1.97 and 1.98.

Also on April 28, 1994, the following papers were filed by applicant: (1) Declaration of Isidor Straus (Paper No. 33), (2) Reply Brief to Examiner's Answer [pursuant to 1.193] (Paper No. 32), and (3) Reply Brief Declaration of Dr. Mitchell Swartz

* Application for patent filed September 17, 1991

Paper No. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**MAILED**

OCT 13 1995

PATENT OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCESEx parte MITCHELL R. SWARTZ

Appeal No. 94-2920

Application No. 07/609,970

ORDER REMANDING TO EXAMINER

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Application for Patent filed September 17, 1991

Appeal No. 94-2920
Application 07/760,970

(also numbered Paper No. 32). In response to the Reply Brief, the examiner entered a letter (Paper No. 35) dated May 13, 1994 indicating that the reply brief had been entered and considered. However, there is nothing in the record indicating that the examiner considered the appropriateness of items (1) and (3) above under 37 C.F.R. 1.195. Likewise, a Petition to the Commissioner Pursuant to 37 C.F.R. 1.181 (Paper No. 27) was filed January 7, 1994 and remains unanswered.

Accordingly, it is

ORDERED that the application is remanded to the examiner for consideration of the appropriateness of the Information Disclosure Statement, and it is

FURTHER ORDERED that the application is remanded to the examiner for consideration of the appropriateness of the Declaration of Isidor Straus (Paper No. 33) and the Reply Brief Declaration of Dr. Mitchell Swartz (Paper No. 32), and it is

FURTHER ORDERED that the application is remanded to the examiner for consideration of the Petition to the Commissioner Pursuant to 37 C.F.R. 1.181 (Paper No. 27).

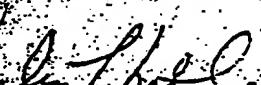
A communication must be sent to applicant indicating the

Appeal No. 942-2916
Application 07/760,970

Examiner's position with respect to all issues set forth above.

The application, by virtue of its "special" status, requires immediate action. (See Manual of Patent Examining Procedure, § 708.01(d). It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the appeal.

BOARD OF PATENT APPEALS
AND INTERFERENCES

By: 

AMALIA I. SANTIAGO
Program and Resources Administrator
(703) 308-9797

CC: MITCHELL R. SWARTZ
16 PEMBROKE ROAD
WESTON, MA 02193

**RESPONSE UNDER 37 CFR 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 3641**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor : Mitchell R. Swartz

Serial no. 09/ 750,765

Filed: 12/28/00

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LOADED WITHIN A MATERIAL**

This is a continuation of Serial no. 07/ 760,970

Filed: 09/17/1991

Group Art Unit: 3641

Examiner: Mr. Palabrica, R.J.

DECLARATION OF DR. MITCHELL SWARTZ

I, Mitchell R. Swartz, declare that I am a citizen of the United States of America and the inventor of the invention described in the above-entitled application.

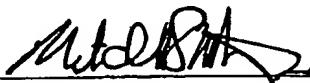
1. I have a background in electrical engineering, material science, electrophysics, nuclear physics and electrochemistry and have worked in this field for more than a decade. I have worked on experimental projects at the Massachusetts Institute of Technology, Massachusetts General Hospital and elsewhere.
2. The Examiner sent me a Communication Of 3/20/03 (Exhibit "A", attached).
3. The Examiner did not include Form 1449 despite the fact that he provided NEW material (after FINAL).
4. The Examiner did not include and return the checked-off Form 1449 of the Exhibits which I supplied to rebut him.
5. The Examiner has not addressed several sections of my Response of 12/3/02. In fact, many of the Examiner's previous questions have simply been re-asked.
6. The Examiner has not addressed the previously-submitted Declarations, merely giving false explanations without substantive foundation and explanation.

7. The Examiner stated new material was the "*Change from 'applied magnetic field' to 'applied spatially inhomogeneous magnetic field'*". This is not true because this was discussed in the patent application of which the present application is a continuation, and discussed in several Declarations submitted previously.

8. The Examiner stated, "...this "something additional", this critical feature, must be clearly specified so as to enable the artisan to make and use the invention as required by statute." However, the Examiner has ignored that this was fully discussed in the previous communication from the applicant to the Examiner, dated 12/3/02. The nature of the invention, along with introduction of some of the Declarations, was discussed in the previous communication from the Applicant to the Examiner, dated 12/3/02, is on page 11 and 12. The operability of this invention was discussed in the previous communication from the Applicant to the Examiner, dated 12/3/02, including on pages 57 though 85. The role of loading in the operability of this invention was discussed in the previous communication from the Applicant to the Examiner, dated 12/3/02, on pages 57-58. The role of the optimal operating point in the operability of this invention was discussed in the previous communication from the Applicant to the Examiner, dated 12/3/02, on pages 59-60 and 66. The equations associated with the loading, and the catastrophic behavior of the loaded isotopic fuel, was discussed in the previous communication from the Applicant to the Examiner, dated 12/3/02, on pages 61 through 65, and 70-71. Applicant's extensive publications, and supporting publications, was discussed in the previous communication from the Applicant to the Examiner, dated 12/3/02, on pages 72-74. The Examiner has ignored many of the Applicant's detailed Arguments.

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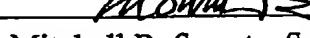
Respectfully submitted,



Mitchell R. Swartz, ScD, MD

I declare that all statements herein of my own knowledge are true and that all statements made on information and belief are believed to be true.

Signature of Inventor:
May 5, 2003



Mitchell R. Swartz, ScD, MD, EE
Post Office Box 81135
Wellesley Hills, Mass. 02481



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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7590 03/20/2003
Mitchell R. Swartz, ScD, EE, MD
16 Pembroke Road
Weston, MA 02493

EXAMINER

PALABRICA, RICARDO J

ART UNIT PAPER NUMBER

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DATE MAILED: 03/20/2003

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EXHIBIT "A"